



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,532	09/18/2006	Young-Hwan Kim	00973-05	9076

34444 7590 03/10/2009
UNIVERSITY OF VIRGINIA PATENT FOUNDATION
250 WEST MAIN STREET, SUITE 300
CHARLOTTESVILLE, VA 22902

EXAMINER

MEAH, MOHAMMAD Y

ART UNIT	PAPER NUMBER
----------	--------------

1652

MAIL DATE	DELIVERY MODE
-----------	---------------

03/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,532

Applicant(s)

KIM ET AL.

Examiner

MD. YOUNUS MEAH

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/11/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-37 are pending in the instant office action.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I claims 1-5, and 20-21, drawn to sperm flagellar energy carrier protein comprising SEQ ID NO: 2 or SEQ ID NO: 4 and composition comprising the said polypeptide.

Group II claims 6-15, drawn to expression vector, Host cell and a DNA fragment comprising SEQ ID NO: 1 or 3 encoding sperm flagellar energy carrier protein.

Group III claims 16-19, 28-31 and 37, drawn to antibodies that bind protein of group I and composition contain said antibodies.

Group IV claims 22-24, drawn to method of diagnosing and treating diseases associated with sperm flagellar energy carrier protein using regulator of sperm flagellar energy carrier polypeptide.

Group V claims 25-27, drawn to method of regulating sperm flagellar energy carrier protein expression using regulator of sperm flagellar energy carrier an antibody.

Group VI claims 32-36, drawn to method of screening compounds that inhibit sperm flagellar energy carrier protein expression or function in a cell.

The inventions listed in Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

corresponding special technical features for the following reasons:

The "special technical feature" linking group I-VI inventions is sperm flagellar energy carrier protein of group I.

However; sperm flagellar energy carrier protein recited in claim 1 does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature which defines a contribution over the prior art as explained below:

Applicants claim 1 is directed to a variant of sperm flagellar energy carrier protein which comprise a homolog, derivative or fragment of SEQ ID NO: 4. Wiemann (Accession NO: ABU53218) teach a sperm flagellar energy carrier protein having 89% homology to applicants protein of SEQ ID NO: 4. Therefore Wiemann et al's sperm flagellar energy carrier protein having 89% homology to applicants protein of SEQ ID NO: 4 reads on variant of sperm flagellar energy carrier protein comprising a homolog, derivative or fragment of SEQ ID NO: 4 of instant claim 1. Therefore; the protein of claim 1 does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature which defines a contribution over the prior art as a sperm flagellar energy carrier protein having 89% homology to applicants protein of SEQ ID NO: 4 is taught Wiemann thorough (Accession NO: ABU53218).

The technical feature of groups I-III is different compounds having different technical feature that does not share with others.

The technical feature of Group IV-VI is the method steps using particular reagents. Said steps in group V include method of treating diseases, a feature that is not shared with other methods such as method of detecting inhibitor of protein or regulating expression of protein. While the products of Group III can be used in the methods of Group V-VI, they do not share their technical feature with Group III because these products can be used in other methods having other technical features, such as in detecting protein.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NASHAAT T NASHED can be reached on 571-272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-1261.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad Younus Meah
Examiner, Art Unit 1652

/Nashaat T. Nashed/
Supervisory Patent Examiner, Art Unit 1652